

Application No.: 10/627827

Docket No.: 05579-00309-US

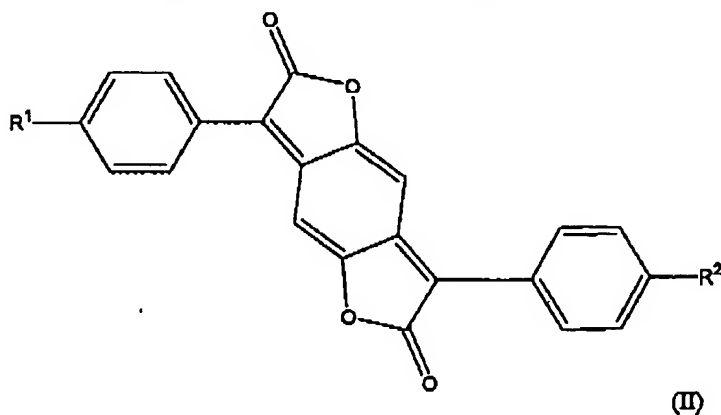
REMARKS

Applicant respectfully request reconsideration in view of the following remarks. Claims 10-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeneca, Ltd. WO 95/21958 ("Zeneca WO '958") in view of Zeneca, Ltd. WO 97/04031 ("Zeneca WO '031"). The applicant respectfully traverses this rejection.

Zeneca WO '958 and Zeneca WO '031 are discussed in the applicant's specification at page 5 lines 6 and 7. The applicant acknowledges that the dyes according to the general formula (I) are known from Zeneca WO '958 and that the dyes according to the general formula (II) are partially known from Zeneca WO '031. Thus the state of the art discloses the single components of the inventive mixture and their use as disperse dyes, optionally in conjunction with other disperse dyes. However, neither of the Zeneca publications discloses that the mixture of formula (I) and (II) should be used together.

Zeneca WO '031 discloses at page 1 that according to the invention there is provided a disperse dye mixture which comprise, on a weight basis,

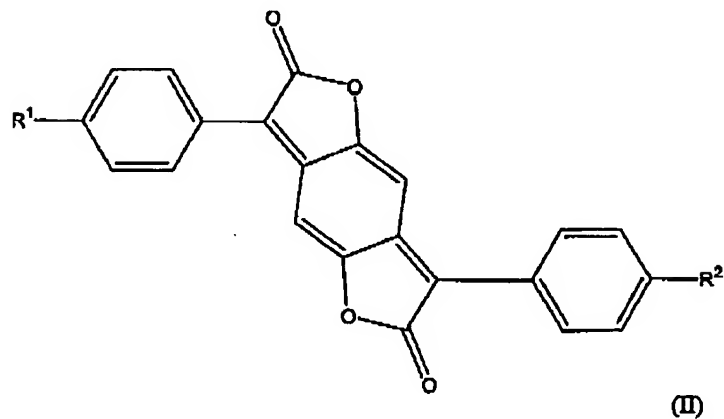
from 5% to 70% of the dye of Formula (1)



with R¹ as hydrogen,

R² as ORCOOR¹OR²

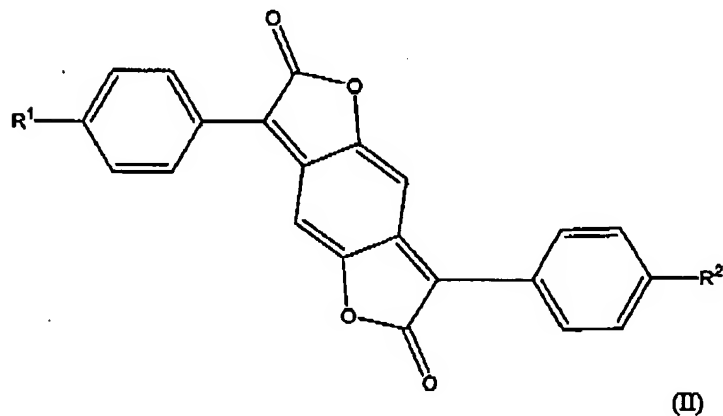
and from 5% to 70% of the dye of the formula (2)



with R^1 as OR^3 ,

R^2 as $ORCOOR^1OR^2$

and from 0% to 40% of the dye of the formula (3)



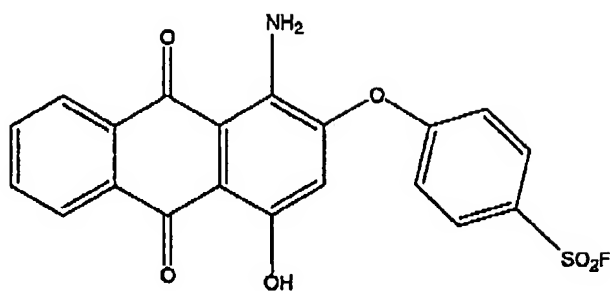
with R^1 as hydrogen,

R^2 as OR^3 (see pages 1 and 2 of Zeneca WO '031). There is no suggestion or teaching to

use the applicant's specifically claimed formula (I)

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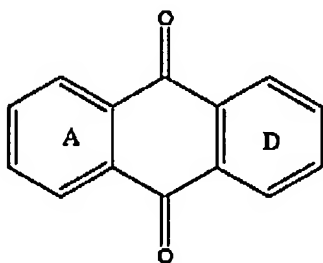
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(I)

In fact, formulas (1), (2) and (3) of Zeneca all have the basic structure of the applicant's formula (II). The percentages of formulas (1), (2) and (3) in Zeneca WO '031 can add up to 100%. Again, there is no disclosure to mix the applicant's formula (I) with the dyes of Zeneca WO '031.

Zeneca WO '958 discloses a process of coloring comprising the dyes of Formula (1)



Formula (1)

which includes the applicant's formula (I).

Zeneca WO '958 states at the bottom of page 1,

"Different compounds of Formula (1) may be mixed or compounds of Formula (1) may be mixed with dyes which do not contain an -SO₂F group, such mixtures are a feature of the present invention."

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There is no suggestion or teaching to use the dyes of the applicant's formula (II) in a mixture with Zeneca WO '958.

Both of the references are assigned to Zeneca. Zeneca WO '031 was filed in Great Britain on July 15, 1995, while Zeneca WO '958 was filed over one year earlier in Great Britain on February 10, 1994. If it is as obvious as asserted by the Examiner, then Zeneca would have included the dyes of Zeneca WO '958 in the disclosure that was over one year later, Zeneca WO '031.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless the prior art suggested the desirability of such modification (In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984); In re Baird, 29 USPQ 2d 1550 (CAFC 1994) and In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (in a determination under 35 U.S.C. § 103 it is impermissible to simply engage in a hindsight reconstruction of the claimed invention; the references themselves must provide some teaching whereby the applicant's combination would have been obvious); In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (under 35 U.S.C. § 103, both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure). The applicants disagree with the Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to

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arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish prima facie case of obviousness (In re Geiger, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Zeneca WO '958 and Zeneca WO '031.

Assuming arguendo that the Examiner has made a prima facie case of obviousness, the applicant believes that the previously submitted Declaration of Shinsuke Ono rebutted this presumption by establishing how the mixtures establish unexpectedly a synergism in the build up behavior. The Examiner asserted that the declaration was not commensurate in scope and the applicant respectfully disagrees. The dye of the formula (I) is a specific dye. The dye of the formula (II) only has two variables R^1 and R^2 . The declaration shows that the mixture of the dyes results in unexpected results. There was no teaching in the prior art to mix these dyes. The applicant's specification also has 24 examples showing the mixture of dyes (I) and (II) according to the applicant's invention.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05579-00309-US from which the undersigned is authorized to draw.

Respectfully submitted,

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